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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,254	06/23/2000	Steven W. Abrahams	05997.0013-00	9350

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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WASHINGTON, DC 20005

EXAMINER
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SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/602,254

Applicant(s)

ABRAHAMS ET AL.

Examiner

Narayanswamy Subramanian

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-10, 15-17 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 8-10, 15-17, 36-42 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This communication is in response to the request for continued examination filed on December 9, 2003. Amendments to claims 8, 9, 15 and 36 and addition of new claims 37-42 made by the Applicants in their request have been entered. Claims 8-10, 15-17 and 36-42 are pending in the application and these claims are subject to restriction/election requirement as discussed below.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 8-10, 37, 38 and 40, drawn to a method for issuing a guarantee certificate, which is a financial instrument representing an obligation of a first party to make a payment triggered by certain default-related events associated with real estate loans or assets, the method comprising the steps of: pooling, into a reference pool, instruments representing payment obligations triggered by certain default-related events associated with real estate loans or assets underlying the instruments; identifying and segregating cash flows paid to satisfy triggered payment obligations for the instruments in the reference pool; and issuing a guarantee certificate to entitle a holder of the certificate to receive at least one payment from the identified and segregated cash flows, classified in class 705, subclass 38.

II. Claims 15-17, 36, 39, 41 and 42, drawn to a method for issuing a guarantee certificate, which is a financial instrument representing an obligation of a party to make payments triggered by certain default-related events involving a real estate loan or assets, the method comprising the steps of: pooling real estate loans or assets into a reference pool; determining a payout formula based on the obligation triggered by certain default-related events

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involving the real estate loans or assets in the reference pool; and issuing a conveyable guarantee certificate that entitles its holder to receive from the party at least one payment determined by the payout formula, classified in class 705, subclass 38.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method for issuing a guarantee certificate, which is a financial instrument representing an obligation of a first party to make a payment triggered by certain default-related events associated with real estate loans or assets, the method comprising the steps of: pooling, into a reference pool, instruments representing payment obligations triggered by certain default-related events associated with real estate loans or assets underlying the instruments; identifying and segregating cash flows paid to satisfy triggered payment obligations for the instruments in the reference pool; and issuing a guarantee certificate to entitle a holder of the certificate to receive at least one payment from the identified and segregated cash flows, whereas invention II relates to a method for issuing a guarantee certificate, which is a financial instrument representing an obligation of a party to make payments triggered by certain default-related events involving a real estate loan or assets, the method comprising the steps of: pooling real estate loans or assets into a reference pool; determining a payout formula based on the obligation triggered by certain default-related events involving the real estate loans or assets in the reference pool; and issuing a conveyable guarantee certificate that entitles its holder to receive from the party at least one payment determined by the payout formula. The steps of identifying and segregating cash flows paid to satisfy triggered

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payment obligations for the instruments in the reference pool is present in Invention I but not in Invention II, and the steps of determining a payout formula based on the obligation triggered by certain default-related events involving the real estate loans or assets in the reference pool is present in Invention II but not in Invention I. Clearly these methods are different and distinct from each other, and also the utility of invention I is different from that of invention II. These two inventions also require separate searches. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Mr. William J. Brogan on February 25, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

5. Applicants are advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to The Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
February 26, 2004

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Richard Weisberger

Primary Examiner